REMARKS

This amendment is responsive to the Office Action dated November 14, 2006. Claims 1 - 20 are pending in this application and have been rejected. Reexamination is respectfully requested.

These remarks follow the order of the outstanding Office Action beginning at page 2 thereof.

Specification

The Examiner's suggestions for language amendments at pages 1, 3, 16, and 21 have been adopted.

Claim Objections

The Examiner's suggestions for language changes in the claims to make them clearer has been followed. This applies to claims 1, 5, 16, 17 and 18.

Claim Rejections - 35 USC § 112

Claims 6 - 12 have been rejected under 35 USC § 112(first paragraph) as failing to comply with the enablement requirement.

Claims 6 and 7 (Now Canceled)

Claims 6 and 7 were independent claims. Each of these

claims was rejected under 35 USC § 112 on the grounds that they do not meet the enablement requirement (first paragraph). This type of rejection is discussed at MPEP § 2164.08(A) and again at MPEP § 2181.V. Both of these sections rely upon the cited case which is In re Hyatt, 708F.2d 712, 218 USPQ 195 (Fed. Cir. 1983).

In re Hyatt relates to a claim which was found to be a single means claim and, hence, not to qualify under the exception otherwise set forth in 35 USC § 112(sixth paragraph). In the Hyatt decision the claim read, ". . . comprising incremental means for incrementally generating the Fourier transform . . ."

The Hyatt decision clarified a long-standing principle that single means claims were not patentable under 35 USC § 112. Hyatt holds that single means claims are not patentable under 35 USC § 112(first paragraph). However, the Hyatt decision is directed to a claim that includes a means plus function statement. Applicant's claims 6 and 7 do not include the term "means" at all.

Applicant has provided enablement for claims 6 and 7 in Applicant's specification where Applicant teaches examples such as Figures 2 and 3 that show the apparatus for printing and reprinting character or data on the trading card in the gaming machine. There can be no doubt that Applicant's specification is enabling for character data changing in a trading card of a gaming machine. However, Applicant claim elements, such as the trading card storing character data (a memory) and having surface

printed with the details of the character. Moreover, the character data is printable a plurality of times. These are two independent elements, namely the storing the storing of the character data (memory chip), and printing (that visible by the card collector or player)(see claim 6). Claim 6 does not recite a means and has at least three elements. Similarly, Applicant in claim 7 provides that the character data is repeatably erasable and printable. Claim 7, like claim 6, does not include the word "means" at all. In claim 7, there are distinct elements which are storing of character data, the surface printed with the character data, and repeatable, erasable, printable character data. Applicant provides disclosure to support this claim as generally seen in Figures 2 and 3 and the accompanying description.

Applicant's trading card, as shown in Figure 5A, shows a chip (25) which provides memory, and Applicant's Figures 8 and 9 show the changing of detail of printed character data. In Figure 8, the character changes by receiving a helmet and having an ax change to a sword. Also, storing card data, such as offensive and defensive characteristics, can be changed.

Claims 8 - 12 Enablement, 35 USC § 112

Claims 8 - 12 depend from claims 6 and 7 and, therefore, by definition provide additional structure and detail. The Examiner has erroneously rejected these claims (now pending claims 10 -

12) because they are not enabling. The true rejection should be that they are dependent (according to the Examiner) from a non-enabling claim and that they would be allowable if rewritten to include the limitations of the parent claims. There has been no rejection of claims 10 - 12 that would show that they include the word means or that they do not add additional structural details or elements to claims 6 and 7. For this reason, the rejection of claims 10 - 12 as non-enabling is traversed. The correct rejection would be that they are dependent from non-enabled claims only (assuming the rejection of claim 7 is correct).

Claim Rejections - 35 USC § 102

Claims 1, 5 - 7, 9, 13 and 17 have been rejected as being anticipated by Nakamura '162. Claims 6 - 9 are canceled for reasons not related to this rejection. Claims 1, 5, 13 and 17 remain.

Applicant's Trading Card

Applicant's trading card can best be understood by reference to Figure 5 which shows details of the trading card. The trading card includes printed detail, such as the picture of the robot and printed information on the face of the card which gives information to the player. At the surface is a protective layer and beneath it is rewritable layer (22). Layer (23) provides color. Independent from the write and read layers (21 - 23) is a

separate area which is a chip (25) and antenna (26). Data may be written into chip (25). Thus Applicant's trading card has two main features, the data in the trading card and the information providing detail of character data on the surface of the trading card.

Nakamura '162

Nakamura has a different concept of a trading card. Nakamura's trading card (72) does not include a memory chip. The Examiner has pointed to Figures 11A and 11B as illustrating the printing of card (72). Here it should be noted that the printing operation of card (72) does not provide for placing data into a memory on card (72). Instead, the data is in a separate device which is called a memory card (68). Information from memory card (68) is read out to provide information to print the card (72) (see column 10, lines 44 - 45). As can be seen in Figure 3A, the gaming machine includes two inputs, input (70) is for receipt of the portable information storage device, and (72) outputs the printed card. The game, therefore, requires the portable information storage device and only outputs a printed card at the end of the game. As discussed above, the printed card does not include a memory. All memory is placed in memory card (68), which is a different device according to '162. In the description of Figures 11A, 11B, 12A and 12B, beginning in column 12, it is shown that card (72) (printed card) while providing

information to the player, (which is visual). The memory card (68) is also a portable information storage device (54) (column 7, lines 65 - 67).

Claim 1

Claim 1 requires an updating device that writes change character data in the trading card in accordance with proceeding of the game. This is a change in the trading card memory provided by Applicant which is placed in Applicant's trading card memory (25). On the other hand, as pointed out above, '162 provides no such trading card memory. '162 uses separate card (68).

Next, Applicant in claim 1 states that the updating is in accordance to a state of proceeding with the game. This is the game in progress, and the memory of the card is updated during play.

The printing of the trading card which would be the last paragraph of claim 1, occurs at the end of the game when information is placed visually on the surface of the trading card.

Claim 5

Claim 5 relates to gaming machines arranged in parallel which, shown in Applicant's Figure 1, are the satellites (12). In Applicant's invention the updating device and the printing

device are duplicated in each of the satellites. Claim 5 is clearly patentable over the arcade game machines shown in '162 on the right hand side of Figure 2. As pointed out above, '162 does not write to a memory in the trading card (72).

Claim 6 - 9

Although the rejection of claims 6 - 12 under 35 USC § 112 as being non-enabling is traversed, claims 6 - 9 have been canceled for other reasons.

Claim 13

The trading card of '162, as pointed out above, does not store character data and also have a surface printed with detailed with detailed character data. Instead, the trading card has no memory at all and the system utilizes a memory card (68) for data storage.

Claim 17

'162, as pointed out above, uses a memory card (68) to hold character data. The trading card of '162 has no memory and there is no teaching in '162 that the trading card is updated with changed character data in response to a change in character data according to proceeding with the game. In '162, the trading card is printed once and has no data updating capability at all. Still further, once a trading card is printed in '162, it cannot

be changed. Therefore, '162 does not respond to the last paragraph of claim 17.

Claim Rejections - 35 USC § 103

Claims 2 - 4

The rejection of claims 2 - 4 as being unpatentable over Nakamura in view of Takemoto '685 is respectfully traversed. The Examiner is correct in stating that Nakamura fails to suggest an erasing device that erases detail of the character. The Examiner should also note that Nakamura never teaches changing of the card. The card is printed but once and issued to the card holder as pointed out in these remarks with respect to claim 1. On the other hand, Takemoto teaches repeatedly recording and erasing printed detail. However, even when the references are combined, there is no suggestion to provide the recording and reproduction feature in Nakamura. The Examiner merely discusses the fact Takemoto has the capability of recording an erasure. However, the rejection does not explain why one would be motivated to change Nakamura to a read/write capability upon issuance of the trading card.

The Examiner argues that it would be obvious to replace the printer of Nakamura. However, it is much more than the printer that must be replaced. It must be the entire operation of the game and product of the game, namely a trading card containing both recorded data and printed data wherein the printed data is

changed.

The Examiner has shown no motivation in this art or concern in this art about "waste of natural resources by saving paper". The motivations in the game art are the play of the game and providing of trading cards to players that will encourage their play. Stated another way, players are not interested in waste of natural resources and neither are owners of gaming machines.

Claims 14 - 16

This rejection is a repeat of the rejection of claims 2 - 4. Therefore, the above comments with respect to claims 2 - 4 also apply with respect to claims 14 - 16.

Claims 10 - 12

Claims 10 - 12 stand rejected under 35 USC § 103 as being unpatentable over Ohta in view of Kazushi '682. Claim 10 is now independent.

Claim 10

Claim 10 is former independent claim 7 and dependent claim 10. The Examiner asserts that Applicant recognizes that Kazushi discloses the printing and erasing process concerning the re-writable card. This is a teaching of Applicant's specification of use of the re-writable card, but it is not a suggestion in the prior art of combining the prior art readable card with a gaming

machine trading card which will achieve a gaming machine trading card having the color re-writable recording medium characteristics claimed. Stated another way, it is Applicant's specification that suggests the combination and not the references themselves. Applicant's specification cannot be used as such a teaching of combinations.

Publication 08-080682 is directed only to the color re-writable recording medium and recording method using the same. There is no suggestion as to where or how this may be used. Similarly, the Ohta reference does not suggest use of color or any advantage of color in the disclosed integrated circuit card. The integrated circuit card of Ohta is disclosed in a different context than a trading card where character data is stored, and collection is intended (Applicant's field of invention). Instead, Ohta is in the field of membership cards, prepaid cards, cash cards, computer passes and the like. There is no reason given in Ohta for resorting to additional color to make the card attractive to users.

For the above reasons, there is no suggestion or reason to combine Ohta and Kazushi '682.

Claims 18 - 20

Claims 18 - 20 are rejected under 35 USC § 103 as being unpatentable over Nakamura in view of Ohta. Nakamura is a gaming device that lacks the feature of reprinting, as pointed out with

respect to these remarks discussing claim 1. On the other hand, Ohta is a reprintable IC card where the printed detail can be changed. The combination of Ohta and Nakamura, however, is not suggested by either reference or the references taken in combination. While Nakamura teaches a gaming device that outputs a trading card, Nakamura provides no suggestion or reason to use a card where the printing is changed. Nakamura, as correctly noted by the Examiner, does not change the printed data on the face of the card. Still further, Nakamura does not provide such a suggestion of a change, and provides no system that would accomplish such a feature.

On the other hand, Ohta is an IC card capable of changing print. Ohta standing alone does not suggest changing a Nakamura card to a reprintable IC card format.

For this reason, the rejection of claims 18 - 20 is respectfully traversed.

The Examiner argues that motivation would be to make forgery of cards more difficult. The Examiner does not explain how change of print appearance would prevent some one else from also changing the print. This is an assumption of the Examiner that is not mentioned in the art of record. In Applicant's specification, the purpose of changing the face of the card is to make them more collectable and visible by the player or collector of cards. The motivation set forth in Applicant's specification is not found in either of the references.

With respect to claim 19, the Examiner argues that it would be obvious to one of ordinary skill in the art to add a printing/erasing device adapted to take advantage of the reversible recording layer of the IC card. However, the Examiner does not explain why it would be obvious to modify the fundamental operation of Nakamura to provide such a feature.

With respect to claim 20, the Examiner notes that Applicant appears to be invoking the sixth paragraph of 35 USC § 112 which requires that such claims be interpreted as the means shown in the specification and equivalents thereof. On the other hand, Ohta does not show any means even similar to those shown in Applicant's Figures 2 and 3, and certainly does not teach or suggest anything which would be equivalent to the apparatus and structure shown in Applicant's specification. For this reason, Claim 20 is clearly patentable.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action in accordance thereof is requested. In the event there is any reason why the application cannot be allowed in this current condition, it is respectfully requested that the Examiner contact

the undersigned at the number listed below to resolve any problems by Interview or Examiner's Amendment.

Respectfully submitted,

Ronald R. Snider
Reg. No. 24,962

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Snider & Associates
Ronald R. Snider
P.O. Box 27613
Washington, D.C. 20038-7613
Tel.: (202) 347-2600

RRS/bam